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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/941,118	08/28/2001	Christopher J. Bradford	IN-5518	6528

26922 7590 01/21/2004

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EXAMINER	
BERMAN, SUSAN W	
ART UNIT	PAPER NUMBER
1711	

DATE MAILED: 01/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action	Application No.	Applicant(s)	
	09/941,118	BRADFORD ET AL.	
	Examiner	Art Unit	
	Susan W Berman	1711	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 12 November 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

a) ☒ The period for reply expires *6* months from the mailing date of the final rejection.

b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1.☒ A Notice of Appeal was filed on *18 November 2003*. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.

2.☐ The proposed amendment(s) will not be entered because:

(a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);

(b) ☐ they raise the issue of new matter (see Note below);

(c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or

(d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____.

3.☐ Applicant's reply has overcome the following rejection(s): _____.

4.☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

5.☒ The a)☐ affidavit, b)☐ exhibit, or c)☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: *see attached pages*.

6.☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

7.☒ For purposes of Appeal, the proposed ~~amendment(s)~~ response a)☐ will not be entered or b)☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: *1-19*.

Claim(s) withdrawn from consideration: *20-30*.

8.☐ The proposed drawing correction filed on _____ is a)☐ approved or b)☐ disapproved by the Examiner.

9.☐ Note the attached Information Disclosure Statement(s)(PTO-1449) Paper No(s). _____.

10.☐ Other: _____

Susan W Berman
Primary Examiner
Art Unit: 1711

Response to Amendment

No amendments to claims 1-26 have been presented in the papers filed 11-12-2003. It is noted that claims 1-30 are pending in the instant application, claims 20-30 having been withdrawn from consideration.

Response to Arguments

Applicant argues that Lahrmann et al disclose two separate coating compositions, one of which is radiation cured and the other of which is heat cured while the instantly claimed invention is a single coating composition comprising radiation curable and heat curable components. This argument is not persuasive for the following reasons. Lahrmann et al clearly disclose radiation curable compositions comprising (meth)acrylate-functional prepolymers or oligomers, photoinitiators, photosensitizers, thermally activatable free-radical initiators and binders in one composition. The radiation curable binders in the disclosed compositions can contain further functional groups accessible to chemical crosslinking (applicant's a1, optionally including a12) and external crosslinking agents can be added. Additionally, Lahrmann et al teach that binders not susceptible to radiation curing and providing a non-radiation-induced curing reaction through functional groups, such as hydroxyl, oxirane or isocyanate, may also be added (applicant's a2). See column 5, line 4, to column 7, line 11. Lahrmann et al specifically mention an OH-functional binder and a polyisocyanate curing agent to be added to the radiation curable lacquer to provide curing by two combined curing mechanisms (column 6, line 65, to column 7, line 11). Thus Lahrmann et al clearly teach compositions comprising both radiation curable and heat curable functionality in the same composition.

Lahrmann et al disclose, in Example 6, a composition comprising a urethane acrylate containing hydroxyl functional groups corresponding to applicant's component (a1), acrylate-functional monomers and a polyisocyanate curing agent (corresponding to applicant's component (a3)) that is irradiated and then heated to provide a high gloss surface. Example 6 clearly shows a composition comprising a

radiation curable urethane acrylate having hydroxyl functional groups in combination with a polyisocyanate and dual cure of the composition. It is the examiner's position that it would have been obvious to one skilled in the art at the time of the invention to provide a composition comprising components corresponding to instantly claimed (a1) and (a3) selected from the prepolymers, binders and crosslinking agents taught by Lahrmann et al because such a composition is taught in Example 6. It is the examiner's position that it would further have been obvious to one skilled in the art at the time of the invention to include a non-radiation curable binder containing functional groups reactive with a polyisocyanate, as taught by Lahrmann et al in column 6, lines 43, to column 7, line 5, of the disclosure because a polyisocyanate is used as crosslinking agent in Example 6. One of ordinary skill in the art at the time of the invention would have been motivated by the teaching of Lahrmann et al to provide a composition curable by radiation and heat to provide an initial gel and avoid sagging on lacquer coated vertical surfaces or to allow flash off of solvents, as taught in column 7, line 44, to column 8, line 34. Thus motivation is clearly provided by the teachings of Lahrmann et al.

Applicant also argues that Lahrmann et al do not suggest the use of binders (corresponding to applicant's (a2)) that have less than 5% by weight aromatic moieties. It is not agreed that nothing in Lahrmann et al suggests binders having low levels of aromatic moieties. Lahrmann et al teach that epoxy (meth)acrylate prepolymers having thermally curable functional groups should contain no aromatic moieties, but do not mention whether the other kinds of prepolymers can or cannot contain aromatic moieties. However, aromatic-containing binders are not suggested or employed in the examples (column 5, lines 12-18). The binders in the examples do not contain aromatic moieties, thus one of ordinary skill in the art would not be motivated to employ binders having aromatic moieties. Furthermore, applicant has not provided any comparative evidence of record to show that compositions wherein the binders contain less than 5 wt. % (including zero wt %) aromatic moieties provide significantly different or improved properties or other results compared with the same compositions wherein the binders contain 5 wt. % or

more aromatic moieties. When the prior art suggest the instantly claimed compositions, the burden is shifted to applicant to show that unexpected results flow from the limitations argued.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan W Berman whose telephone number is 571 272 1067. The examiner can normally be reached on M-F 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on 571 272 1078.

The fax phone numbers for the organization where this application or proceeding is assigned are 703 872 9306 for regular communications and 703 872 9306 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571 272 1200.

Susan Berman

Susan W Berman
Primary Examiner
Art Unit 1711

SB
1/13/04